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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Straub & Pokotylo 788 Shrewsbury Avenue Tinton Falls, NJ 07724			LASTRA, DANIEL	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/814,104	Applicant(s) BUCHHEIT ET AL.	
	Examiner DANIEL LASTRA	Art Unit 3688	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 July 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-38 and 40-92 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-38 and 40-92 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-38 and 40-92 have been examined. Application 10/814,104 (RENDERING CONTENT-TARGETED ADS WITH E-MAIL) has a filing date 03/31/2004.

Response to Amendment

2. In response to Non Final Rejection filed 09/23/2008, the Applicant filed an Amendment on 12/23/2008, which amended claims 1-53, 65, 80, 83-87, 89, 91. Applicant's amendment overcame the Section 101 rejection. Applicant's argument filed 07/20/2009 is persuasive, therefore, the Examiner is reopening prosecution and entering amendment filed 07/20/09, where claim 39 was cancelled.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-23, 25-69 and 71-92 are rejected under 35 U.S.C. 102(b) as being anticipated by Werkhoven (WO 02/25507)

Claims 1 and 47, Werkhoven teaches:

A computer-implemented method for facilitating the serving of advertisements with e-mail content, the method comprising:

a) accepting, with a web-based e-mail serving system including at least one computer, a request for a document: including e-mail content (see page 3, lines 10-15)

b) generating, with the web-based e-mail serving system, request identifier (see page 3, lines 10-15);

c) serving to a client device, with the web-based e-mail serving system, the requested document in association with the request identifier (see page 3, lines 10-15);

d) obtaining, with the web-based e-mail serving system, at least one ad relevant to the e-mail content (see page 9, lines 1-10);

e) storing, with the web-based e-mail serving system, the obtained at least one ad (see page 3, lines 30-35);

f) accepting, with the web-based e-mail serving system, an ad request from the client device (see page 3, lines 30-35);

g) reading, with the web-based e-mail serving system, the stored at least one ad using information from the ad request (see page 3, lines 30-35); and

h) serving to the client device, with the web-based e-mail serving system, the at least on ad read (see page 3, lines 30-35).

Claims 2 and 48, Werkhoven teaches:

wherein the ad request from the client device is generated automatically, without a manual input from a user of the client device (see page 3, lines 10-15).

Claims 3 and 49, Werkhoven teaches:

wherein the ad request was sourced by the client device when it rendered the requested document (see page 3, lines 101-15).

Claims 4 and 50, Werkhoven teaches:

wherein the ad request was sourced by a client device after it rendered the requested document (see page 2, lines 30-37).

Claims 5 and 51, Werkhoven teaches:

wherein the ad request was sourced by a browser when it rendered the requested document (see page 3, lines 10-15).

Claims 6 and 52, Werkhoven teaches:

wherein the ad request was sourced by a browser after it rendered the requested document (see page 2, lines 20-37).

Claims 7 and 53, Werkhoven teaches:

wherein the act of storing the obtained at least one ad includes storing the request identifier in association with the at least one ad (see page 3, lines 30-37).

Claims 8 and 54, Werkhoven teaches:

wherein the request identifier may be used as a primary key to lookup the associated at least one ad (see page 3, lines 30-37).

Claims 9 and 55, Werkhoven teaches:

wherein the ad request includes the request identifier (see page 3, lines 30-37).

Claims 10 and 56, Werkhoven teaches:

wherein the act of reading the stored at least one ad using information from the ad request uses the request identifier to lookup the associated at least one ad (see page 3, lines 30-37).

Claims 11 and 57, Werkhoven teaches:

wherein the act of serving the requested document in association with the request identifier is performed by a first thread, and wherein the act of obtaining at least one ad relevant to content of the e-mail is performed by a second thread (see page 3, lines 1-5).

Claims 12 and 58, Werkhoven teaches:

wherein the execution of the first thread is independent of the execution of the second thread (see page 2, lines 35-37).

Claims 13 and 59, Werkhoven teaches:

wherein the act of obtaining at least one ad relevant to content of the e-mail includes submitting an ad request to a content-relevant ad server (see page 9, lines 1-10).

Claims 14 and 60, Werkhoven teaches:

wherein the ad request includes the request identifier (see page 6, lines 5-20).

Claims 15 and 61, Werkhoven teaches:

wherein the document including e-mail content represents an individual e-mail message (see page 6, lines 10-25).

Claims 16 and 62, Werkhoven teaches:

wherein the document including e-mail content represents a group of e-mail messages (see page 6, lines 1-10).

Claims 17 and 63, Werkhoven teaches:

wherein the document including e-mail content represents an e-mail thread output as a conversation (see page 9, lines 1-15).

Claims 18 and 64, Werkhoven teaches:

wherein the document including e-mail content is a conversation view including a group of e-mails (see page 9, lines 1-15).

Claims 19 and 65, Werkhoven teaches:

A method for rendering ads in association with e-mail content, the method comprising:

a) requesting with a client device, a document including e-mail content (see page 2, lines 1-35);

b) accepting with the client device the document (see page 3, lines 10-15);

c) rendering with the client device the document (see page 3, lines 10-15);

d) requesting with the client device at least one ad relevant to the e-mail content of the document (see page 3, lines 25-35);

e) receiving with the client device the at least one ad (see page 3, lines 25-35);
and

f) rendering with the client device the at least one ad in association with the rendered document, wherein the at least one ad is rendered after the e-mail content of the document has already been rendered (see page 4, lines 30-37).

Claims 20 and 66, Werkhoven teaches:

wherein the accepted document includes a request identifier and wherein the act of requesting at least one ad relevant to the e-mail content of the document includes generating a request including the request identifier (see page 3, lines 30-35).

Claims 21 and 67, Werkhoven teaches:

wherein the act of requesting at least one ad relevant to the e-mail content of the document occurs after the act of rendering the e-mail content of the document (see page 9, lines 1-10).

Claims 22 and 68, Werkhoven teaches:

wherein the document is a Web-page (see page 3, lines 1-15).

Claims 23 and 69, Werkhoven teaches:

wherein the act of requesting at least one ad relevant to the e-mail content of the document includes constructing a URL that represents a request for at least one ad (see page 3, lines 30-37).

Claims 25 and 71, Werkhoven teaches:

wherein the document is a Web page, and wherein the act of rendering the at least one ad in association with the rendered e-mail content of the document includes manipulating a document object model of the Web page to render the ads (see page 3, lines 30-37).

Claims 26 and 72, Werkhoven teaches:

wherein the act of rendering the at least one ad in association with the rendered document is done such that the document is not modified (see page 2, lines 20-37).

Claims 27 and 73, Werkhoven teaches:

forwarding the document to another client, wherein the at least one ad is not rendered on the other client device (see page 2, lines 20-37).

Claims 28 and 74, Werkhoven teaches:

wherein the act of rendering the at least one ad in association with the rendered document is done such that the at least one ad does not become a part of the document (see page 2, lines 25-37).

Claims 29 and 75, Werkhoven teaches:

forwarding the document to another client, wherein the at least one ad is not rendered on the other client device (see page 2, lines 25-37).

Claims 30 and 76, Werkhoven teaches:

wherein the document including e-mail content is an individual e-mail (see page 2, lines 25-37).

Claims 31 and 77, Werkhoven teaches:

wherein the document including e-mail content is group of e-mails (see page 2, lines 25-37).

Claims 32 and 78, Werkhoven teaches:

wherein the document including e-mail content is an e-mail thread (see page 2, lines 25-37).

Claims 33 and 79, Werkhoven teaches:

wherein the document including e-mail content is a conversation view including a group of e-mails (see page 9, lines 1-12).

Claims 34 and 80, Werkhoven teaches:

A method for facilitating the serving of advertisements with e-mail content, the method comprising:

a) accepting with a web base email serving system including at least one computer a request for a document including e-mail content (see page 2, lines 10-37);
b) generating with the web base email serving system a request identifier (see page 3, lines 30-37);

c) serving to a client device, with the web base email serving system the requested document in association with the request identifier (see page 3, lines 30-37); and

d) obtaining with the web base email serving system at least one additional content item relevant to the e-mail content (see page 9, lines 1-20).

e) storing, with the web-based e-mail serving system, the obtained at least one additional content item (see page 3, lines 30-37);

f) accepting, with the web-based e-mail serving system, an additional content item request from the client device (see page 3, lines 30-37);

g) reading, with the web-based e-mail serving system, the stored at least one additional content item using information from the additional item request (see page 3, lines 30-37); and

h) serving to the client device, with the web-based e-mail serving system, the at least on additional content item read (see page 3, lines 30-37).

Claims 35 and 81, Werkhoven teaches:

wherein the at least one additional content item is selected from a group consisting of (a) a news article, (b) an excerpt of a news article, (c) a search query, (d) a product review, and (e) an excerpt of a product review (see page 9, lines 1-30).

Claims 36 and 82, Werkhoven teaches:

herein the at least one additional content item includes at least one content relevant ad and at least one further additional content item selected from a group consisting of (a) a news article, (b) an excerpt of a news article, (c) a search query, (d) a product review, and (e) an excerpt of a product review (see page 9, lines 1-10).

Claims 37 and 83, Werkhoven teaches:

Wherein the additional item request from the client device is generated automatically, without a manual input from a user of the client device (see page 2, lines 25-30).

Claims 38 and 84, Werkhoven teaches:

wherein the at least one additional content item is selected from a group consisting of (a) a news article, (b) an excerpt of a news article, (c) a search query, (d) a product review, and (e) an excerpt of a product review (see page 9, lines 1-10).

Claims 39 and 85, Werkhoven teaches:

wherein the at least one additional content item includes at least one content relevant ad and at least one further additional content item selected from a group consisting of (a) a news article, (b) an excerpt of a news article, (c) a search query, (d) a product review, and (e) an excerpt of a product review (see page 9, lines 1-10).

Claims 40 and 86, Werkhoven teaches:

A method for facilitating the serving of advertisements with electronic messaging content, the method comprising:
a) accepting with a web base electronic message serving system including at least one computer a request for a document including electronic messaging content (see page 2, lines 1-37);

b) generating with the web base electronic message serving system a request identifier (see page 2, lines 10-37);

c) serving to a client device with the web base electronic message serving system the requested document in association with the request identifier (see page 3, lines 25-37); and

d) obtaining with the web base electronic message serving system at least one ad relevant to the electronic messaging content (see page 3, lines 25-37).

e) storing, with the electronic message mail serving system, the obtained at least one ad (see page 3, lines 25-37);

f) accepting, with the electronic message serving system, an ad request from the client device (see page 3, lines 25-37);

g) reading, with the electronic message serving system, the stored at least one ad using information from the ad request (see page 3, lines 25-37) and

h) serving to the client device, with the electronic message serving system, the at least on ad read (see page 3, lines 25-37).

Claims 41 and 87, Werkhoven teaches:

Wherein the ad request from the client device is generated automatically, without a manual input from a user of the client device (see page 2, lines 25-30).

Claims 42 and 88, Werkhoven teaches:

wherein the electronic messaging content is content from one of (A) on-line groups, (B) blogs, (C) message postings, and (D) instant messaging (see page 9, lines 1-10).

Claims 43, 89 and 91, Werkhoven teaches:

A method for rendering ads in association with electronic messaging content, the method comprising:

a) requesting with a client device including at least one computer a document including electronic messaging content (see page 2, lines 10-35);

b) accepting with the client device the document (see page 2, lines 10-35);

- c) rendering with the client device the document (see page 2, lines 10-35);
- d) requesting with the client device at least one ad relevant to the electronic messaging content of the document (see page 9, lines 1-10);
- e) receiving the at least one ad (see page 9, lines 1-10); and
- f) rendering with the client device the at least one ad in association with the rendered document, wherein the at least one ad is rendered after the electronic messaging content of the document has already been rendered (see page 4, lines 30-37).

Claims 44, 90 and 92 Werkhoven teaches:

wherein the electronic messaging content is content from one of (A) on-line groups, (B) blogs, (C) message postings, and (D) instant messaging (see page 9, lines 1-10).

Claim 45 Werkhoven teaches:

A computer implemented method for facilitating the serving of advertisements with electronic messaging content, the method comprising:

- a) accepting with a web base electronic message serving system including at least one computer a request for a document including electronic messaging content (see page 2, lines 10-35);
- b) generating with the web base electronic message serving system a request identifier (see page 2, lines 10-35);

c) serving to the client, with the web base electronic message serving system the requested document in association with the request identifier (see page 2, lines 10-35); and

d) obtaining with the web base electronic message serving system at least one additional content item relevant to the electronic messaging content (see page 9, lines 1-10).

e) storing, with the web-based electronic serving system, the obtained at least one additional content item (see page 3, lines 30-37);

f) accepting, with the web-based electronic serving system, an additional content item request from the client device (see page 9, lines 1-10);

g) reading, with the web-based electronic serving system, the stored at least one additional content item using information from the additional item request (see page 9, lines 1-10); and

h) serving to the client device, with the web-based electronic serving system, the at least on additional content item read (see page 9, lines 1-10)

Claim 46 Werkhoven teaches:

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wherein the electronic messaging content is content from one of (A) on-line groups, (B) blogs, (C) message postings, and (D) instant messaging (see paragraph 2) (see page 9, lines 1-10).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 24 and 70 are rejected under 35 U.S.C. 103(a) as being unpatentable over Werkhoven (WO 02/25507).

Claims 24 and 70, Werkhoven does not expressly mention:

wherein the act of requesting at least one ad relevant to the e-mail content of the document further includes instantiating an ActiveX object that takes the URL and requests the at least one ad from a Web-based e-mail server that sourced the document. However, Official Notice is taken that it is old and well known in the promotion art to instantiates an ActiveX object in order to pull an ad. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Werkhoven would instantiate ActiveX to obtain ads, as it is old and well known to do so.

Response to Arguments

5. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL LASTRA whose telephone number is 571-272-6720 and fax 571-273-6720. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ROBERT A WEINHARDT can be reached on (571)272-6633. The official Fax number is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/DANIEL LASTRA/
Examiner, Art Unit 3688
August 1, 2009